UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,658	10/09/2001	Fu Chen	10133	1375

28006 7590 04/03/2006

HERCULES INCORPORATED
HERCULES PLAZA
1313 NORTH MARKET STREET
WILMINGTON, DE 19894-0001

EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/976,658
Filing Date: October 09, 2001
Appellant(s): CHEN ET AL.

David Edwards
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 3, 2005 appealing from the Office action mailed December 22, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 1-15, 17-31, 33-38, 40 and 42-48.

Claims 16, 32, 39 and 40 have been canceled.

(4) Status of Amendments After Final

The appellant does not state the status of amendments after final rejection other than the filing of the Request for Reconsideration.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,444,747	Chen et al	9-2002
02/083592	WIPO	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15, 17-31, 33-38, 40 and 42-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al (US 6,444,747).

Chen et al teach the instant co- and ter-polymers throughout the patent, especially in examples, and their use as rheology modifiers for concrete and cement additives at col. 1, lines 7-8. The recited terpolymer of the instant claim 48 is taught by the claim 10 of Chen et al.

Thus, the instant invention lacks novelty.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1, 5-12, 18-20, 22-24, 26-28, 30 and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 02/083592.

WO teaches slurry compositions comprising the instant copolymers of acrylic acid and polyethyleneglycol monoallyl ether sulfate (page 2, lines 14-15) and gypsum (page 1, line 26). Said polyethyleneglycol encompasses the instant repeating unit and molecular weight thereof inherently. Preamble (building material) has little probative value especially in view the instantly recited "comprising" which permits the presence of any component in any amount.

Thus, the instant invention lacks novelty.

(10) Response to Argument

A. Appellant asserts that the proper Terminal Disclaimer filed on April 8, 2004 would overcome the double patenting rejection as well as anticipation rejection based on Chen et al. However, such assertion lacks any probative value since appellant failed to submit 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131 and since a court held that the instant rejection is valid. See ***In re Bartfield, USPQ 2d 1685 (fed. Cir. 1991)*** and MPEP 804.03.

B. Appellant asserts that WO 02/083592 is a non-analogous art since it is directed to a method of decreasing the viscosity of a mineral ore slurry while the instant invention is directed to a building material composition. Appellant asserts that the term "building material" is defined in the bridging paragraph on pages 7 and 8, and it must include 2 to about 99 wt.% of binder. Appellant also asserts that the gypsum of WO may (or may not) contain sulfates which contain celestite or gypsum and that it is not certain that gypsum is present since the ore from different locations have different components. Appellant further asserts that the ore is not a loose component that can act as a binding material and that the examiner failed to give any weight to the instant preamble, building material.

Appellant argues that WO is a non-analogous art, but the examiner's position is that said argument on a non-analogous art is only valid on the combined references, not on a single reference as in the instant case. Any art teaching a combination of the instant polymer and cement or gypsum would meet the invention regardless of its use.

With respect to the definition of the term "building material" and an amount of a binder, the composition of WO meets the instant building material (even though the examiner does not give any weight to the said preamble) since WO teaches a mixture of the instant copolymer and gypsum, and an amount of a binder is not claimed. The limitation taught in the specification cannot be read into the claim interpretation.

With respect to appellant assertion that the gypsum of WO may be celestite or gypsum, WO teaches gypsum and thus appellant's assertion that said gypsum may be celestite has no probative value.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tae H. Yoon

Primary Examiner

AU 1714

March 27, 2006

Conferees:

Vasu Jagannathan,

SPE, AU 1714

James Seidleck,

SPE, AU 1711